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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/776,503	02/02/2001	Dale Blackson	D-1132 R	9612
28995	7590	07/05/2007		
RALPH E. JOCKE walker & jocke LPA 231 SOUTH BROADWAY MEDINA, OH 44256			EXAMINER PATEL, JAGDISH	
			ART UNIT 3693	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/776,503	Applicant(s) BLACKSON ET AL.	
	Examiner JAGDISH PATEL	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-6, 8-54 and 56-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 6, 22, 26-30, 32-33, 35, 40, 41, 43, 50, 60, 66, 68, 69, 73, 76, 77 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims rejected are 2-5,8-21,23-25,31,34,36-39,42,44-48,53,54,56-59,61-65,67,70-72,74,75,79-81,83,84 and 86.

DETAILED ACTION

1. This communication is in response to amendment filed 9/25/06.

Response to Amendment

2. Claims 2-6, 8-54, and 56-86 are pending. The amendment of the pending claims have been entered as requested. At least some of the pending claims have been found rejectable over newly found prior art. This action accordingly is issued as a Non-final rejection.

Reassignment of the Application to New Examiner

3. A new examiner has been assigned to this application. All future correspondence should be directed examiner Jagdish Patel (Primary Examiner AU 3693).

Claim Objection

Claim 82 is objected as being improperly dependent product claim dependent upon a method claim. The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

In the instant case, a product such as a CD-ROM would not infringe on the process of method claim 58 whereas it would infringe on the computer-readable medium of claim 82.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 51, 52 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. Claims 51 and 52 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

-that of an account charged for audio output to the structural elements of the apparatus recited claims 46 and 48 respectively.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-5, 8-21, 23-25, 31, 34, 36-39, 42, 44-48, 53-54, 56-59, 61-65, 67, 70-72, 74-75, and 79-81, 83, 84, 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over PETERS

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et al. (WO 95/30212) (PETERS) and further in view of Bank Network News ("Internet Technology Pushes New Services to ATMs (Canadian Imperial bank of Commerce (Toronto) will test Internet-type technology to tailor ATM offerings to the need of cardholders"), v 15, n 22, p.7, 4/11/97 ("BNN") and further in view of Lu et al. US Pat. 6035336 (LU).

(NOTE: Unless otherwise indicated the text location in brackets following the claim refers to PETERS reference)

Claim 3. PETERS teaches an automated transaction machine apparatus comprising: (Fig. 1)

at least one computer processor; (video computer 36)

at least one data store in operative connection with the at least one computer processor, wherein the at least one computer processor is operative to cause a plurality of digital information files to be retrieved from at least one digital information source located remotely from the machine and saved in the data store;

(see p. 17 B. The Databases in particular, sales database p.21, or fourth database which is inventory database p.22)

at least one user input device in operative connection with the at least one computer processor, wherein the at least one user input device is operative to receive user input;

(see p. 24 L 20 – p. 25 L 9 card reader 52, see also Key Pad 72)

a cash dispenser device in operative connection with the at least one computer processor, wherein the at least one computer processor is operative to cause the cash dispenser to dispense currency responsive to at least one first user input through the at least one user input device;

(see p 28 L 18+ bill acceptor that also dispenses cash..)

and

at least one output device in operative connection with the at least one computer processor, wherein the at least one output device is connectable to a portable computing device,

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wherein the at least one computer processor is operative to cause dispense of at least one digital sound recording file of the digital information files through the at least one output device responsive to at least one second user input through the at least one user input device that corresponds to wherein the at least one digital information file includes a digital sound recording file, and wherein the at least one computer processor is operative to cause dispense of the same digital sound recording file to plural users.

(see p. 37 product delivery sequence and vending computer 74 which is in connection with video computer 36, see p. 39 cassette player with head phone, the vending computer is operative to cause dispense of digital sound recording file (digital information in the form of audio data files, see p. 16 L 18,)), it is also noted that the music video referenced in PETERS is also equivalent to digital sound recording file which may be dispensed to a plural users).

PETERS fails to teach that the at least one computer processor is operative to cause the cash dispenser to dispense currency responsive to at least one first user input.

However, the BNN article, in conjunction with LU the same field of endeavor teaches automatic transaction machine (ATM or ABM) which are operable to dispense (inherently through an output device) digital files (digital sound recording file) and offering cash dispensing functions via the use of a credit or debit card (inherent function of ATM). BNN further teaches "Push technology" on the Internet, which provides capabilities to download the "information an individual desires". Therefore, BNN also teaches a dispenser having capabilities to connect to a portable computing device of the user. Lu discloses an apparatus for providing a user with desired, remotely stored information using "push technology". Lu teaches "A class of portable information tools has appeared on the market in recent years. These tools include cordless cellular telephones, laptop computers, "personal digital assistant" devices, etc. Many of such devices have interfaces for accepting downloaded information for later, stand-alone use by the user. An increasing number of such devices also have audio playback capabilities." Refer to col. 11

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to improve PETERS in view of BNN and further in view of LU to provide for the at least one computer processor provide for dispensing of the currency responsive to a first user input through the user input device and dispensing of the digital files through a second user input from the user input device because it would enable the ATM to offer customized digital files including music audio and video files to their choice of portable devices.

Claim 2. The apparatus according to claim 3 wherein the at least one user input device comprises a card reader device in operative connection with the at least one computer processor, wherein the card reader device is operative to read account data indicia from a card, and wherein the at least one computer processor is operative to cause an account corresponding to read account data to be charged one or more fees to be charged to the account corresponding to the a dispense of currency and the a dispense of the at least one digital sound recording file.

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(see card reader 52 as discussed before and functions of ATM in combination with BNN and LU references).

Claim 4. wherein the at least one digital information sound recording files includes an MP3 file.

(refer to PDA in Lu patent)

Claim 5. wherein the at least one output device includes a sound system, and wherein the at least one computer processor is operative to cause the output of sound through the sound system responsive to the at least one digital sound recording file.

(see PETERS p.39)

Claims 8 and 9. (original) The apparatus according to claim 8 wherein the at least one output device is releasibly operatively connectable to a portable computing device and comprises a communications port releasibly operatively connectable to a portable computing device adjacent the machine.

(see claim 4 analysis which includes PDA connectable to the output device)

Claim 10. Apparatus comprising:

PETERS teaches an automated transaction machine including:

at least one input device;

(see p. 24 L 20 – p. 25 L 9 card reader 52, see also Key Pad 72)

a cash dispenser, wherein the cash dispenser is operative to deliver cash from the machine responsive to at least one input to the at least one input device;

(see p 28 L 18+ bill acceptor which also dispenses cash..)

at least one output device, wherein the at least one output device is connectable to a portable computing device, wherein the at least one output device is operative to cause delivery of digital content including at least one sound recording file responsive to at least one digital content delivery fee authorization input to the at least one input device, and wherein the at least one output device is operative to cause delivery of the same digital content to different entities.

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(see p. 37 product delivery sequence and vending computer 74 which is in connection with video computer 36, see p. 39 cassette player with head phone, the vending computer is operative to cause dispense of digital sound recording file (digital information in the form of audio data files, see p. 16 L 18,)), it is also noted that the music video referenced in PETERS is also equivalent to digital sound recording file which may be dispensed to a plural users).

Claim 11. The apparatus according to claim 10 wherein the at least one sound recording file comprises a music recording file. (see claim 10 analysis)

Claim 12. The apparatus according to claim 10 wherein the at least one digital sound recording file comprises at least one audiovisual file.
(see claim 10 analysis)

Claim 13. The apparatus according to claim 10 wherein the at least one input device is adapted to receive at least one input corresponding to an account, and wherein the machine further includes:

at least one processor, wherein the processor is in operative connection with the at least one input device, the cash dispenser and the at least one output device, and wherein the processor is operative to cause the account to be charged for at least one of delivered cash and digital content.

(see analysis of PETERS in view of BNN and LU).

Claim 14. The apparatus according to claim 13 wherein the at least one input device includes a card reader, and wherein the input corresponding to an account is produced responsive to at least one card read by the card reader.

(see p. 24 L 20 – p. 25 L 9 card reader 52, see also Key Pad 72)

Claim 15. The apparatus according to claim 13 wherein the processor is operative to cause content indicia corresponding to a plurality of portions of the digital content to be output through the at least one output device, and wherein the processor is operative to cause a selected portion of the digital content to be delivered responsive to at least one selection input corresponding to the selected portion, through the at least one input device.

(p. 31 Menu and Price list L 14-p. 32 L10)

Claim 16. (original) The apparatus according to claim 15 wherein the machine includes a display device and the content indicia is output through the display device.

(p. 31 Menu and Price list L 14-p. 32 L10)

Claim 17. (original) The apparatus according to claim 16 wherein the content indicia includes a graphic image corresponding to at least one of the portions of the digital content.

(p. 31 Menu and Price list L 14-p. 32 L10)

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Claim 18. (original) The apparatus according to claim 13 wherein the apparatus comprises at least one content data store, wherein the digital content is delivered from the content data store.
(p. 21 sales database)

Claim 19. (original) The apparatus according to claim 18 wherein the content data store comprises a local content data store located in the machine.
(p. 21 sales database)

Claim 20. (original) The apparatus according to claim 18 and further comprising:
at least one network in operative connection with the machine; and
at least one remote computer in operative connection with the network, wherein the content data store is in the at least one remote computer.
(p. 29, L 10-19 refer to Tele-switch)

Claim 21. (currently amended) The apparatus according to claim 20 and further comprising:
at least one financial transaction computer in operative connection with the at least one network, wherein the at least one processor is operative to cause the account to be charged through communication with the at least one financial transaction computer through the at least one network.
(see p. 25 p. 1-9, credit card service bureau linkage connected to the vending machine computer 10)

Claim 23. (original) The apparatus according to claim 19 and further comprising:

at least one network in operative connection with the machine; and
at least one remote computer in operative connection with the network, wherein the at least one remote computer includes at least one remote content data store.
(see p. 29 L 10-15)

Claim 24. (original) The apparatus according to claim 23, wherein the machine is operative to selectively deliver digital content from either the local content data store or the remote content data store responsive to at least one input to the at least one input device.
(see p. 29 L 5-15, refer to “three sources of audio information” and “other destinations”)

Claim 25. (original) The apparatus according to claim 23 wherein the processor is operative to cause digital content in the remote content data store to be stored in the local content data store.
(see p. 24 7-11)

Claim 31. (currently amended) The apparatus according to claim 13 and further comprising:

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at least one network in operative connection with the machine,
at least one financial transaction computer in operative connection with the at least one network,
wherein the at least one processor is operative to cause the account to be charged responsive to
communication through the at least one network with the at least one financial transaction
computer.

(Inherent in view of p. 24 L 20- p. 25 L 9 and p. 37 L 6-11 credit card payment process)

Claim 34. (original) The apparatus according to claim 31 wherein the account is associated with
a user of the machine, and wherein the at least one financial transaction computer includes the
account, and wherein the account is debited responsive to either delivery of cash or delivery of
digital content.

(refer to analysis of claim 3)

Claim 36. (currently amended) The apparatus according to claim 31 wherein the output device
includes a reproduction device operative to reproduce the digital content.

(see claim 4 analysis which includes PDA connectable to the output device)

Claim 37. (currently amended) The apparatus according to claim 36 wherein the reproduction
device is operative to cause the digital content to be reproduced in a the portable computing
device.

(see claim 4 analysis which includes PDA connectable to the output device)

Claim 38. (original) The apparatus according to claim 37 wherein the digital content is
reproduced in the portable computing device such that it can only be played in the portable
computing device.

(see claim 4 analysis which includes PDA connectable to the output device)

Claim 39. (original) The apparatus according to claim 37 wherein the digital content is
reproduced in the portable computing device such that it cannot be further transferred in digital
form from the portable computing device.

(see claim 4 analysis which includes PDA connectable to the output device)

Claim 42. (currently amended) The apparatus according to claim 36 wherein the reproduction
device is operative to reproduce the digital content on the portable storage medium media.

(see claim 4 analysis which includes PDA connectable to the output device)

Claim 44. (currently amended) The apparatus according to claim 10 wherein the digital content
is delivered by being reproduced in the portable computing device.

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(refer to downloading feature as per claim 2 analysis)

Claim 45. (currently amended) The apparatus according to claim 31 wherein the at least one output device includes a sound system, and wherein the sound system is operative to output the digital content as audio output is delivered thorough audio outputs through the sound system.

(Refer to PETERS as discussed in claim 3 analysis)

Claim 46. (currently amended) The apparatus according to claim 10 wherein the at least one output device includes a sound system, and wherein the sound system is operative to output the digital content as audio output.

(Refer to PETERS as discussed in claim 3 analysis)

Claim 47. (currently amended) The apparatus according to claim 31 wherein the at least one output device includes an audiovisual output device, and wherein the audiovisual output device is operative to output the digital content is as audiovisual

(Refer to BNN as discussed in claim 3 analysis)

Claim 48. (currently amended) The apparatus according to claim 10 wherein the at least one output device includes an audiovisual output device, and wherein the audiovisual output device is operative to output the digital content as audiovisual output.

(Refer to BNN as discussed in claim 3 analysis)

Claim 53. (currently amended) The apparatus according to claim 10 wherein the automated transaction machine further comprises:

a currency acceptor, wherein the machine is further operative to deliver the digital content responsive to deposit of cash into the currency acceptor.

(refer to claim 3 analysis of PETERS in view of BNN and LU references, also Refer to Figure 1 of PETERS "Bill Acceptor 70")

Claim 54. (currently amended) The apparatus according to claim and further comprising a currency acceptor, wherein the at least one computer processor is further operative to cause the dispense of the at least one digital sound recording file responsive to deposit of currency into the currency acceptor.

(refer to claim 3 analysis of PETERS in view of BNN and LU references, also Refer to Figure 1 of PETERS "Bill Acceptor 70")

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Claims 56-59, 61-65, 67, 70-72, 74-75, and 79-81 have been analyzed as per respective apparatus claims above and have rejected on same rationale.

Claim 83. The apparatus according to claim 3 wherein the at least one computer processor is operative to cause a charge of at least one fee associated with the a dispense of at least one digital sound recording file.

(see p. 37 L 6-14)

Claim 84. (currently amended) The apparatus according to claim 10 wherein the machine is operative to cause a charge of at least one fee associated with the delivery of digital content.
(see p. 37 L 6-14)

Claim 86. recites method performed by apparatus recited in claim 3 and rejected on basis of rationale discussed in claim 3 analysis.

Allowable Subject Matter

8. Claim 85 and 49 are allowed.

Claims 6, 22, 26-30, 32-33, 35, 40, 41, 43, 50, 60, 66, 68,69, 73, 76,77 are objected as being dependent upon rejected claim(s).

Conclusion

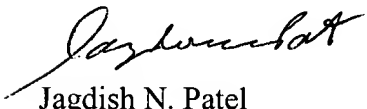
Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH PATEL whose telephone number is (571) 272-6748.

The examiner can normally be reached on 800AM-630PM Mon-Tue and Thu.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **KRAMER JAMES A** can be reached on **(571)272-6783**. The fax phone number for the organization where this application or proceeding is assigned is 517-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jagdish N. Patel

(Primary Examiner, AU 3693)

6/10/07